

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit
Examiner

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Washington
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GROUP 180

In re Application of:

LLOYD M. SMITH ET AL.

Case No.: 148-120CIP3

Serial No.: 106,232

Filed: 10/7/87

For: AUTOMATED DNA SEQUENCING TECHNIQUE

COMMISSIONER OF PATENTS AND TRADEMARKS
WASHINGTON, D.C. 20231

SIR:

PETITION AND AMENDMENT UNDER RULE 48


Applicants hereby petition to amend the above-identified patent application to correct the inventorship by adding the name of Charles R. Connell, a U.S. citizen, residing at 167 King St., Redwood City, CA 94062, to the list of inventors.

A verified STATEMENT OF FACTS under Rule 48 that is signed by all of the originally named inventors is attached hereto explaining the circumstances of the error in inventorship. Also included is a new corrected declaration of inventorship signed by all of the inventors including Charles R. Connell, and a letter approving the change of inventorship signed by the originally named assignee, the California Institute of Technology.

If any additional fees are required, please charge deposit account 01-2213.

Respectfully submitted,
LLOYD M. SMITH ET AL.

By


Joseph H. Smith
Reg. 30,328

Foster City, CA
(415) 570-6667

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WASHINGTON, D.C. 20231

SIR:

Approval by Assignee for Change
of Inventorship Under 37 C.F.R. 1.48

The California Institute of Technology, the originally named assignee of the above-identified patent application, is fully aware of the request for change of inventorship, and that the corrected inventorship includes Lloyd M. Smith, Leroy E. Hood, Michael W. Hunkapiller, Tim J. Hunkapiller, and Charles R. Connell. The California Institute of Technology approves of this change in inventorship.

Respectfully Submitted,

David W. Morrisroe
Vice President for Business
and Finance and Treasurer
California Institute of Technology

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STATEMENT OF FACTS UNDER RULE 48

The above-identified patent application is a continuation-in-part of co-pending Serial No. 689,013, hereinafter CIP-1, and 722,742, hereinafter CIP-2, both of which are now abandoned. CIP-1 is a continuation-in-part of Serial No. 570,973, hereinafter PARENT 1, now abandoned. CIP-1 and CIP-2 were filed originally under great time pressure caused by impending publications which it was felt might jeopardize rights with respect to foreign filing. As a result, extensive discussions regarding inventorship were not performed prior to their filing and it was assumed incorrectly that the inventorship for CIP-1 and CIP-2 were the same as PARENT-1. Both CIP-1 and CIP-2 were joint inventions of personnel who were then employed by one or both of the California Institute of Technology, hereinafter CALTECH, and Applied Biosystems, Inc., hereinafter ABI, and both applications were assigned to CALTECH by the originally named inventors. During the examination of CIP-2, the Examiner's analysis was reviewed in detail by Dr. Michael Hunkapiller, one of the originally named inventors, who is an employee of ABI. As part of that review, Dr. Hunkapiller happened to collaborate with a colleague at Applied Biosystems, Dr. Charles R. Connell. Dr. Connell, upon reviewing the specification, realized that he too had been involved in the development of significant aspects of the invention described therein, and made that fact known to Dr. Hunkapiller.

That was approximately May 1987. Although it was known previously that Dr. Connell had been involved in the commercial implementation of the invention, the full extent of his involvement in the early development of the invention was not fully appreciated until the Office Action caused a more critical review. Upon reviewing evidence of Dr. Connell's collaboration, it was apparent that Dr. Connell was a co-inventor, at which time Dr. Hunkapiller contacted Applied Biosystems' patent attorney, Mr. Joseph H. Smith, to review the situation. Mr. Smith agreed that the evidence indicated that Dr. Connell was a co-inventor. Hence, Mr. Smith contacted CALTECH's patent attorney, Mr. Edward Ansell, on or about May 29, 1987, and described the situation. Several discussions were held regarding the inventorship situation. However, a number of individuals were difficult to reach due to the summer break in the academic schedule and due to vacation schedules. Nevertheless, to avoid any implication of fraud on the Patent Office, CALTECH, as part of its response to the outstanding Office Action for CIP-2, informed the Patent Office of this third party claim by ABI on September 14, 1987. Further discussions ensued between CALTECH and ABI, and on October 7, 1987, the above-identified patent application was filed as a continuation-in-part of the parent cases CIP-1 and CIP-2, with the Patent Office being informed at that time of the third party claim regarding inventorship by ABI. During the following months, CALTECH and ABI further reviewed the inventorship situation and resolved those issues. Following that resolution, CALTECH and ABI have been involved in negotiating a suitable licensing and marketing arrangement between themselves with regard to the technology. Those negotiations have now been completed, and a more complete claim structure for the instant case is near completion.

It is clear that the error in inventorship was inadvertent and occurred due to the time constraints in filing the above-described applications. Absolutely no deceptive intent was involved, and we support the addition of Charles R. Connell as a joint inventor on this application.

DECLARATION:

As an originally named inventor, I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full Name of 1st Inventor: Lloyd M. Smith
Inventor's Signature: _____ Date _____
Residence: 115 Amherst Drive, Madison, Wisconsin 53705
Citizenship: United States of America
Post Office Address: Same

Full Name of 2nd Inventor: Leroy E. Hood
Inventor's Signature: _____ Date _____
Residence: 1453 E. California, Pasadena, 91009
Citizenship: United States of America
Post Office Address: Same

Full Name of 3rd Inventor: Michael W. Hunkapiller
Inventor's Signature: Michael W. Hunkapiller Date 12/13/1989
Residence: 1333 Pebble Drive, San Carlos, CA 94070
Citizenship: United States of America
Post Office Address: Same

Full Name of 4th Inventor: Tim J. Hunkapiller
Inventor's Signature: _____ Date _____
Residence: _____
Citizenship: _____
Post Office Address: _____